

REMARKS

Claims 23 and 40 are canceled herein. Claims 1-6, 8-19, 21, 22, 24-37, 39 and 41-44 remain pending in the application.

Objection to the Drawings

The Office Action objected to the drawings under 37 CFR 1.83(a) as allegedly lacking features recited in claims 8-11, 19, 21, 23, 24, 38 and 40.

Claims 8-11, 19, 21, 23, 24, 38 and 40 are dependent claims that further restrict their respective independent claims, i.e., simply define the type of motion sensor, proximity detector, etc. In particular, claims 8-11, 19, 21, 23, 24, 38 and 40 respectively further limit the claimed “motion sensor”, “indication unit”, “a GPS receiver”, “a receiver” and a “proximity detector”. The claimed motion sensor is clearly disclosed in Fig. 1 as, e.g., item 120. The claimed indication unit is clearly disclosed in Fig. 1 as, e.g., item 135. The claimed GPS receiver is clearly disclosed in Fig. 1 as, e.g., item 120. The claimed proximity detector is clearly disclosed in Fig. 1 as, e.g., items 120, 115 and 140.

Claims 23 and 40 are canceled herein, making the objection to claims 23 and 40 now moot.

The Applicants respectfully request the objection under 37 CFR 1.83(a) to the drawings as allegedly lacking features recited in claims 8-11, 19, 21, 23, 24, 38 and 40 be withdrawn.

35 USC 112 First Paragraph Rejection of Claims 8-11, 19, 21, 23, 24, 38 and 40

The Office Action rejected claims 8-11, 19, 21, 23, 24, 38 and 40 under 35 USC 112, first paragraph. In particular, the Office Action alleges claimed features are not described in the drawings in such a way as to reasonably convey to one skilled in the art that the inventors, at the time the application was filed, had possession of the claimed invention. The Applicants respectfully disagree.

Claims 8-11, 19, 21, 23 and 24 further restrict the recited “motion sensor” and “proximity detector”, i.e., describing the type of “motion sensor” and

“proximity detector”. Therefore the claimed features found in claims 8-11, 19, 21, 23 and 24 are found in the Fig. 1 as described above.

35 USC 112 Second Paragraph Rejection of Claims 6, 18, 19, 24 and 37

The Office Action rejected claims 6, 18, 19, 24 and 37 under 37 CFR, second paragraph.

In particular, the Office Action rejected claims 6, 19 and 37 as containing a trademark/trade name, BLUETOOTH, that renders the claims 6, 19 and 27 as allegedly uncertain. The Office Action alleges that a trademark cannot be used to properly identify or describe any particular material or product, but is a source of goods, and not the goods themselves. The Applicants were directed to see *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982).

Claims 6, 19 and 37 recite BLUETOOTH™. Contrary to the use of the Trademark in *Ex parte Simpson*, BLUETOOTH™ is an engineering piconet standard that **DOES NOT** represent a source of goods. Any manufacturer that complies with the BLUETOOTH™ standard can identify their product as being BLUETOOTH™ capable. Thus, claims 6, 19 and 37 recite a transceiver that complies with the BLUETOOTH™ engineering standard for a piconet.

In particular, claim 24 allegedly lacks antecedent basis for “said proximity detector”. Claim 24 is amended herein to correct any lack of antecedent basis.

Claims 6, 18, 19, 24 and 37 are in conformance with 37 CFR 112, second paragraph. The Applicants respectfully request the rejection of claims 6, 18, 19 and 37 under 37 CFR 112, second paragraph be withdrawn.

Claims 1-5, 11-15, 18, 24-32, 36 and 41-44 over Merriam in view of Knuth

In the Office Action, claims 1-5, 11-15, 18, 24-32, 36 and 41-44 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over U.S. Patent No. 6,408,187 to Merriam (“Merriam”) in view of U.S. Patent No. 5,406,618 to Knuth (“Knuth”). The Applicants respectfully traverse the rejection.

The Examiner is alleging that the Applicants previously argued that a person of ordinary skill in the art would be totally ignorant(?) of telephone

operations and therefore would not rely on Knuth (See Office Action, pages 19 and 20). The Applicants respectfully disagree.

The Applicants respectfully request the Examiner to re-review the previous response as reiterated herein. Nowhere do the Applicants make the assertion that the Examiner would be totally ignorant of telephone operations and would therefore not rely on Knuth. The Applicants are arguing that Knuth **fails to disclose the claimed features** and that the theoretical combination of Merriam and Knuth would therefore **still NOT** result in the claimed features.

Claims 1-5, 11-15, 18, 24-32, 36 and 41-44 recite a method and apparatus that notifies a user of a message upon sensing a portable wireless device has been moved.

Merriam appears to disclose a portable communication device that determines the proximity of a user to the portable communication device (col. 2, lines 4-7). In the likelihood that a user is within relatively close proximity to the portable communication device, a vibration or visual alert is activated instead of a audio alert (Merriam, col. 1, lines 59-65).

The Office Action acknowledges that Merriam fails to disclose a controller responsive to receipt of a signal for activating a user notification unit to notify a user that a message arrived while the user was presumed not in a vicinity of a portable wireless device (Office Action, page 4).

The Office Action relies on Knuth to allegedly make up for the deficiencies in Merriam to arrive at the claimed invention. The Applicants respectfully disagree.

Knuth appears to disclose a proximity sensor that determines the presence of a user in a vicinity of a telephone answering device (col. 5, lines 1-3). In response to the user being within the vicinity of the telephone answering device, a notice is given to the user that messages await (Knuth, col. 33-38).

Knuth's notification of messages awaiting recovery in a telephone answering device is in response to a proximity sensor that determines the presence of a user in a vicinity of the telephone answering device, the telephone answering device being a **stationary wired device**. Thus, Knuth producing a notification of a message awaiting recovery is in response to proximity sensor

detecting motion within an environment of a stationary telephone answering device is **NOT** a method and apparatus notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 1-5, 11-15, 18, 24-32, 36 and 41-44.

Moreover, even if the theoretical combination of Merriam and Knuth were obvious (which it is not), the result would be a mobile telephone modified to producing a notification of a message awaiting recovery in response to proximity sensor detecting motion within an environment of the mobile telephone when it remains stationary. Neither Merriam nor Knuth disclose, teach or suggest a method and apparatus notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 1-5, 11-15, 18, 24-32, 36 and 41-44.

For these and other reasons, claims 1-5, 11-15, 18, 24-32, 36 and 41-44 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 6, 8-10, 19, 21-23, 37, 39 and 40 over Merriam in view of Knuth and Dorenbosch

In the Office Action, claims 6, 8-10, 19, 21-23, 37, 39 and 40 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Merriam in view of Knuth, and further in view of U.S. Patent No. 6,505,049 to Dorenbosch (“Dorenbosch”). The Applicants respectfully traverse the rejection.

Claims 23 and 40 are canceled herein, making the rejection of claims 23 and 40 now moot.

Claims 6, 8-10, 19, 21, 22, 37 and 39 are dependent on claims 1, 18 and 36 respectively, and are allowable for at least the same reasons as claims 1, 18 and 36.

Claims 6, 8-10, 19, 21, 22, 37 and 39 recite a method and apparatus notifying a user of a message upon sensing a portable wireless device has been moved.

As discussed above, neither Merriam nor Knuth, either alone or in combination, disclose, teach or suggest a method and apparatus notifying a user

of a message upon sensing a portable wireless device has been moved, as recited by claims 6, 8-10, 19, 21, 22, 37 and 39.

The Office Action relies on Dorenbosch to allegedly make up for the deficiencies in Merriam in view of Knuth to arrive at the claimed invention. The Applicants respectfully disagree.

Dorenbosch appears to disclose a communication network that stores location information for the communication network (Abstract). A portable device determines whether the portable device is in motion (Dorenbosch, Abstract). The portable device, lacking on-board location-determination capability, determines its location from a network (Dorenbosch, col. 4, lines 48-65). A location based application, conventionally requiring a user to input a location, uses the location from the network (col. 1, lines 23-34). The determination of motion is used to suppress attempts to obtain location information from the network (Dorenbosch, col. 4, lines 48-65).

Dorenbosch discloses a location based application that uses location information obtained from a network. Motion of a portable device is used to stop attempts to obtain location information from the network. Thus, Dorenbosch's detection of motion for a portable device **suppresses actions** within the portable device, contrary to Applicant's method and apparatus that **take action** in response to detecting that a portable wireless device has been moved, i.e., a method and apparatus notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 6, 8-10, 19, 21, 22, 37 and 39.

Moreover, even if the theoretical combination of Merriam, Knuth and Dorenbosch were obvious (which it is not), the result would be a mobile telephone modified to producing a notification of a message awaiting recovery in response to proximity sensor detecting motion within an environment of the mobile telephone when it remains stationary. The notification of a message awaiting recovery by the mobile telephone would be suppressed until the mobile telephone is not in motion. Neither Merriam, Knuth nor Dorenbosch, either alone or in combination, disclose, teach or suggest a method and apparatus notifying a

user of a message upon sensing a portable wireless device has been moved, as recited by claims 6, 8-10, 19, 21, 22, 37 and 39.

Accordingly, for at least all the above reasons, claims 6, 8-10, 19, 21, 22, 37 and 39 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 16 and 33 over Merriam in view of Knuth and Himmel

Claims 16 and 33 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Merriam in view of Knuth, and further in view of U.S. Patent No. 6,622,015 to Himmel et al. ("Himmel"). The Applicants respectfully traverse the rejection.

Claims 16 and 33 are dependent on claims 1 and 18 respectively, and are allowable for at least the same reasons as claims 1 and 18.

Claims 16 and 33 recite an apparatus notifying a user of a message upon sensing a portable wireless device has been moved.

As discussed above, neither Merriam nor Knuth, either alone or in combination, disclose, teach or suggest an apparatus notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 16 and 33.

The Office Action relies on Himmel to allegedly make up for the deficiencies in Merriam in view of Knuth to arrive at the claimed invention. The Applicants respectfully disagree.

Himmel appears to disclose a method and apparatus for using electronic documents within a smart phone (Abstract). A merchant, legal organization, or other entity provides an electronic document to a subscriber as proof of registration for a service or of legal entitlement (Himmel, Abstract). An appointment or calendar event can be sent as an e-document (Himmel, col. 8, lines 7-30).

The Office Action relies on Himmel to disclose an appointment reminder being sent to a smart phone. However, Himmel fails to disclose that the appointment reminder is given notice to a user upon sensing a portable wireless device has been moved, as recited by claims 16 and 33.

Neither Merriam, Knuth nor Himmel, either alone or in combination, disclose, teach or suggest a method and apparatus notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 16 and 33.

Accordingly, for at least all the above reasons, claims 16 and 33 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Claims 17, 34 and 35 over Merriam in view of Knuth and Narayanaswami

Claims 17, 34 and 35 were rejected under 35 U.S.C. §103(a) as allegedly being obvious over Merriam in view of Knuth, and further in view of U.S. Patent No. 6,477,177 to Narayanaswami et al. (“Narayanaswami”). The Applicants respectfully traverse the rejection.

Claims 17, 34 and 35 are dependent on claims 1 and 18 respectively, and are allowable for at least the same reasons as claims 1 and 18.

Claims 17, 34 and 35 recite an apparatus notifying a user of a message upon sensing a portable wireless device has been moved.

As discussed above, neither Merriam nor Knuth, either alone or in combination, disclose, teach or suggest an apparatus notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 17, 34 and 35.

The Office Action relies on Narayanaswami to allegedly make up for the deficiencies in Merriam in view of Knuth to arrive at the claimed invention. The Applicants respectfully disagree.

Narayanaswami appears to disclose a wearable mobile computing device/appliance (a wrist watch) with a high resolution display that is capable of wirelessly accessing information from a network and a variety of other devices (Narayanaswami, Abstract). A Cirrus Logic CL-EPP7211, a single-chip embedded controller, functions as a CPU for ultra-low-power applications (Narayanaswami, col. 3, lines 51-67). A motion sensor is used for power management, display control, etc. (Narayanaswami, col. 6, lines 1-23).

Although Narayanaswami discloses a motion sensor, the motion sensor is used to control power management and display control **NOT** notifying a user of a message upon sensing a portable wireless device has been moved, as recited by claims 17, 34 and 35.

Accordingly, for at least all the above reasons, claims 17, 34 and 35 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,



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